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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/561,699

05/15/2006

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37388-405600

8167

27717 7590 05/11/2009  
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EXAMINER

TRAN, THUAN Q

ART UNIT

PAPER NUMBER

3693

MAIL DATE

DELIVERY MODE

05/11/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/561,699	<b>Applicant(s)</b> GRINBERG ET AL.	
	<b>Examiner</b> Thuan Tran	<b>Art Unit</b> 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-38, 40-42 and 44-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38, 40-42 and 44-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3-3-2009</u>  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Status of Claims**

1. This action is in reply to the Amendment filed on 3-3-2009.
2. Claims 1, 19, 36, and 40 have been amended.
3. Claims 39 and 43 have been cancelled.
4. Claims 46-52 have been added.
5. Claims 1-38, 40-42, and 44-52 are currently pending and have been examined.

### **Priority**

6. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

### **Information Disclosure Statement**

7. The Information Disclosure Statements filed on 3-3-2009 has been considered.  
An initialed copy of the Form 1449 is enclosed herewith.

### ***Response to Arguments***

8. Applicant's arguments filed in regards to the 35 USC 101 rejection have been fully considered but they are not persuasive. The applicant has attempted to overcome the rejection, however, the applicant's arguments are not sufficient. The rejection under 35 USC 101 has been further detailed in an attempt to clarify the rejection.

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9. Applicant's arguments with respect to claims 1-38, 40-42, and 44-52 have been considered but are moot in view of the new ground(s) of rejection. However, the examiner wishes to address applicant's argument regarding how the interface means is connected to the financial institution.

10. The applicant contends "the customer deal directly with their financial institution and no secure information needs to be provided to the merchant or any other non-trusted party." The examiner disagrees. An "interface means which is arranged to be initiated via a merchant site and is arranged to provide a connection to a financial institution application" is not a direct connection between the interface means and the financial institution. This may be as simple as a interface means passing a security means to the merchant and from the merchant to the financial institution. This is also a connection between the interface means and a financial institution via a merchant.

### ***Claim Objections***

Previous claim objections have been removed.

### ***Claim Rejections - 35 USC § 101***

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claims 1-38, 40-42, and 44-52 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a proper process must be tied to another statutory class or transform

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underlying subject matter to a different state or thing (Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876)). The independent claim 1 states a system which includes steps such as “arranged to be initiated,” and arranged.” It is unclear what part of the system is arranged to perform these steps. The claim further states “processing of payment.” It is unclear what part of the system processes the payment. The claim further states “the connection being implemented.” It is unclear what part of the system is performing the implementing. This is not sufficient to tie the process claim to a particular apparatus in another statutory class. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps (In re Bilski, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008)).

### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. **Claims 1-5, 7-22, 24-36, 40, and 44-52** are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al., US Patent 5,590,197.

14. **As per claims 1, 19, 36, and 40:**

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Chen teaches:

- an interface means which is arranged to be initiated via a merchant site and is arranged to provide a connection to a financial institution application of a financial institution holding an account of the customer (the account provider, see at least column 6 line 13-19) to enable processing of the payment, from the account of the customer via the financial institution application, to a merchant account (see at least column 5 line 42-60),
- the financial institution application requiring a security means to enable processing of the payment, the connection being implemented to enable the security means to be obtained via a customer computing system (see at least column 4 line 63-66)

Examiner notes: the following sections of the claim are considered intended use, thus given no patentable weight:

- to enable processing of the payment, from the account of the customer via the financial institution application, to a merchant account
- to enable processing of the payment, the connection being implemented to enable the security means to be obtained via a customer computing system

15. **As per claims 2 and 20** Chen further teaches:

- wherein the interface means is arranged to enable the payment to proceed in real time (see at least column 6 line 28-57, the steps of the transaction are carried out in real time).

16. **As per claims 3 and 21** Chen further teaches:

- wherein the interface means is arranged to enable the payment to occur during the product transaction (see at least column 6 line 28-57).

17. **As per claims 4** Chen further teaches:

- wherein the interface means is arranged to be initiated by way of a customer computing system accessing the merchant site (see at least column 6 line 28-57).

18. **As per claims 5 and 22** Chen further teaches:

- wherein the interface means is arranged to generate confirmation to a merchant system that payment has occurred (see at least page column 6 line 28-57).

19. **As per claims 7 and 24** Chen further teaches:

- the interface means being arranged to obtain transaction details and provide the details to the financial institution application to facilitate payment (see at least column 6 line 28-57).

20. **As per claims 8 and 25** Chen further teaches:

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- wherein the transaction details include the payment amount (see at least column 6 line 28-57, the payment amount must be included in the transaction details so that the account provider may approve the transaction).

21. **As per claims 9 and 26** Chen further teaches:

- wherein the transaction details include a merchant account identifier (see at least column 6 line 28-57, the merchant embeds information the merchant needs to provide the account servicer, including such items as a merchant identifier).

Examiner notes: the merchant identifier is not patentably different from information the merchant needs to provide the account servicer because both of these are merchant identifying information.

22. **As per claims 10** Chen further teaches:

- wherein the financial institution application is a known pre-existing financial institution application (see at least column 6 line 28-57).

23. **As per claims 11 and 27** Chen further teaches:

- wherein the security means is obtained by enabling the customer to enter the security means via the customer computing system (see at least column 6 line 28-57).

24. **As per claims 12 and 28** Chen further teaches:



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- wherein the security means is stored in a storage location accessible via the customer computing system, and the security means are obtained from the storage location via the customer computing system (see at least column 6 line 28-57).

25. **As per claims 13 and 29** Chen further teaches:

- wherein the security means is stored in encrypted form, and wherein the interface means is arranged to decrypt the encrypted security means (see at least column 5 line 61 to column 6 line 6)

26. **As per claims 14 and 30** Chen further teaches:

- the system including storage means for storing decryption keys for decrypting encrypted security means (see at least column 5 line 61 to column 6 line).

27. **As per claims 15 and 31** Chen further teaches:

- further including a database arranged to store transaction details of transactions (see at least column 6 line 28-57, as the transaction details are sent between the computers, the computers must in some way save the information either in ram, cache, hard drive or some other form of memory for processing).

28. **As per claims 16** Chen further teaches:

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- wherein the database is arranged to be accessible by a merchant system to enable a merchant to obtain details of transactions that they are associated with (see at least column 6 line 28-57, the memory in the merchant computer's computer).

29. **As per claims 17** Chen further teaches:

- wherein the database is arranged to be accessible by customer computing systems to enable customers to obtain details of transactions that they are associated with (see at least column 6 line 28-57, the customer's computer memory).

30. **As per claims 18 and 32** Chen further teaches:

- wherein the interface means is a software agent (see at least column 4 line 43-62).

31. **As per claims 33, 34, 35, 44 and 45** Chen further teaches:

- An operating system (inherently the computer runs on an operating system) that has a computer readable medium (inherently computers have some type of medium for it to store and read information) that provides a computer program instructions to a computer (inherently, computers take instructions from a computer readable medium to perform commands form a user, see at least column 4 line 43-62).

32. **As per claims 46-52** Chen further teaches:

- wherein the financial institution application is an internet banking application (see at least column 6 line 12-18, the account provider)
- wherein the connection is implemented to connect the financial institution application to the customer computing system (see at least column 6 line 28-57).

***Claim Rejections - 35 USC § 103***

33. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

34. **Claims 6, 23, 37 and 41** are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al., US Patent 5,590,197.

35. **As per claims 6 and 23:**

Chen teaches claim 5. He does not specifically teach that the payment confirmation to the merchant is a secure connection. However, Chen further teaches that communication may be encrypted, see at least column 5 line 60 to column 6 line 6. This is a secure connection because this prevents third party access to the information. Together these embodiments of Chen teach:

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- wherein the system is arranged to provide a secure connection between the financial institution application and the merchant system for generation of confirmation that payment has occurred (see at least page 8 line 26-28).

It would have been obvious to one of ordinary skill in the art at the time of the invention to secure the communication between the merchant and the financial institution in increase security and reduce losses due to theft.

**36. As per claims 37 and 41:**

Chen teaches claims 36 and 40. He does not teach that the communications are in the form of e-mails. However, the examiner takes **Official Notice** that it is old and well known in the finance arts to make communications in the form of e-mail messages. It would have been obvious to one of ordinary skill in the art at the time of the invention to communicate through e-mail messages to quickly communicate between parties.

**37. Claims 38 and 42** are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al., US Patent 5,590,197 in view of Mascavage, US 2003/0154164.

**38. As per claims 38 and 42:**

Chen teaches claims 36 and 40 as described above. He does not teach that the message includes a link to a payment means. However, Mascavage teaches:

- Wherein the system message includes a link to enable connection to the payment means (see at least paragraph 0057).

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Together Chen and Mascavage teach an online payment system that includes a message that has a link to a payment means. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine these two with motivation to enable fast and reliable person to person electronic payments.

***Conclusion***

39. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuan Tran whose telephone number is 571-270-1832. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thuan Tran  
Patent Examiner  
4-20-2009

/Stefanos Karmis/  
Primary Examiner, Art Unit 3693